

REMARKS

Claims 2-7, 11-17 and 20-23 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

The applicants acknowledge and appreciate receiving an initialed copy of the form PTO-1449 which accompanied the Information Disclosure Statement that was filed on September 15, 2005.

IMPORTANT - As noted in the previous response, Fujiki et al., U.S. Patent No. 6,847,807 does not appear in either of the forms PTO-892 that accompanied the Office Actions of May 12, 2005 and August 24, 2004, respectively, and was not cited by the applicant in an Information Disclosure Statement. Applicants respectfully request that the Examiner list Fujiki on a Supplemental Form PTO-892 to properly provide a complete prosecution record of cited references.

Claims 2, 6, 7, 11, 17, 20, and 21 were rejected under 35 USC 103(a) as being allegedly unpatentable over Arnold, et al., U.S. Patent No. 5,475,677 (hereinafter "Arnold") in view of Koshi et al. U.S. Patent No. 5,414,527 (hereinafter "Koshi"). The applicants respectfully request that this rejection be withdrawn for the following reasons.

Applicants note that the Examiner has essentially copied the text of the previous rejection adding only that a determination of whether a handset is operating in FDD or TDD mode is made by microcontroller 602 which then switches a synthesizer 301 at an appropriate time, in connection with the alleged teaching in Arnold of the claimed selection by the multiplexer between the first and second data encoders being made according to a predetermined transmit schedule. Applicants are not sure of the relevance of the cited section, particularly since some of

the aspects of the claimed feature have apparently been completely ignored, e.g. a first data encoder for encoding a first transmit data, a second data encoder for encoding a second transmit data, and a multiplexer as claimed. In alleging that Arnold teaches such features, speech encoder 605, channel encoder and multiplexer 607 are cited as allegedly amounting to the claimed first data encoder for encoding a first transmit data, second data encoder for encoding a second transmit data, and the multiplexer. Applicants respectfully disagree with this characterization.

A close review of Figure 6 of Arnold reveals that the speech encoder 605 and channel encoder 607 are in series and thus necessarily cannot teach the claimed features. For example, even if speech encoder 605 is assumed, *arguendo*, to teach the first encoder producing the first transmit data and the channel encoder and multiplexer 607 is alleged to teach the second encoder for producing the second transmit data, the multiplexer 607 clearly *does not* select between the first and second data encoders. Rather, the multiplexer 607 simply outputs the coded speech signal generated by speech encoder 605 along with signaling in fixed length bursts at the appropriate time (see, e.g., *Arnold*, col. 13, lines 19-22).

In reality, however, Arnold does not teach a first and second encoder for producing a first and second transmit signal. Since speech encoder 605 simply encodes an analog speech signal, which is stored in buffer 606, speech encoder 605 cannot fairly be said to teach producing a first transmit signal. Rather, at best, channel encoder 607 produces the only signal for transmission. Further, as noted, there is simply no teaching or suggestion in Arnold that channel encoder and multiplexer 607 selects between a first encoder and a second encoder. Finally, as admitted by the Examiner, Arnold has no teaching of selecting a data encoder more frequently to deliver a predetermined target power as claimed. Contrary to the Examiner's assertion, neither does Koshi, which has been improperly combined with Arnold to allegedly cure the deficiency.

In addressing the improper combination, the Examiner has completely dismissed the applicants' legitimate observation that no evidence has been provided to support the combination of references, which gives rise to a failure in the establishment of the *prima facie* case of obviousness – a serious deficiency in the rejection. In an attempt to address this observation, the Examiner only cites law supporting the very requirement that the Examiner has not met, e.g. that a suggestion or motivation must be contained in the applied references or in the knowledge generally available to those of skill in the art.

The Examiner's requirement is as follows. "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, 977 F.2d 1443, 24 USPQ.2d 1443 (Fed. Cir. 1992). Moreover, to establish a *prima facie* case of obviousness, "it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention." In re Levengood, 28 USPQ.2d 1300, 1301 (Bd. Pat. App. 1993). We submit that the evidence must be clearly identified.

A conclusion of obviousness cannot be supported if there is a failure to point to specific information that teaches or suggests the combination. In re Dembiczak, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ.2d 1313, 1317 (Fed. Cir. 2000). See also, Crown Operations Int'l Ltd. v. Solutia Inc., 289 F.3d 1367, 1376, 62 USPQ.2d 1917 (Fed Cir. 2002) ("there must be a teaching or suggestion within the

prior art, within the nature of the problem to be solved, ... to look to particular elements, and to combine them as combined by the inventor”).)

Thus, a proper response to the lack of evidence would be for the Examiner to provide the missing evidence either in the form of a citation from the references themselves or a statement of the exact knowledge which is alleged to be generally available which would support the combination. In any case, in accordance with the law cited by the Examiner, evidence must be provided to support a *prima facie* case. Otherwise, there is no burden on the applicants to rebut the alleged teachings. The Office Action provides no evidence of a motivation to combine the references, other than a broad, conclusory statement on page 4 of the Final Office Action that the combination of Arnold and Koshi to arrive at the feature of, for example, selecting a first encoder more frequently to deliver a predetermined power simply “would have been obvious.” The statement provides no evidence or factual basis upon which to support the combination. Interestingly, in both cases cited by the Examiner, e.g. *In re Fine* and *In re Jones*, the court found that insufficient support had been provided by the Examiner and **reversed** a finding of obviousness, even where a more tenable basis for supporting the combination was provided than has been provided in the present rejection, see, e.g. MPEP 2143.01(I).

Applicants earnestly note that the allegation of a lack of evidence is not arbitrarily being put forth. In addition to the failure by the Examiner to provide evidence to support combining the references, applicants have provided evidence that one of ordinary skill would not have combined the references. A lengthy discussion of why one of ordinary skill in the art would not look to Koshi to address deficiencies in Arnold was provided in the previous response, which was simply ignored by the Examiner in favor of a terse restatement of the relevant law which establishes the very requirement to provide the evidence.

By way of brief review, applicants believe there is ample evidence that the references would not be combinable since Arnold is drawn to a speech based system and Koshi is drawn to an image processing system. The audio encoder and decoder in Arnold are placed in connection with a microphone and speaker. The encoders of Arnold could not be adapted, particularly without significant modification and experimentation, to process image signals and at such a time they would be unsuitable for their intended purpose. It well known that speech encoding is performed according to coding standards such as A-law, μ -law, and the like, which are not ordinarily compressible due to the uncorrelated nature of speech while video is performed according to entirely different standards such as MPEG and the like which lends itself to compression due to high inter-frame or inter-vector correlation. Thus, the “encoding” methods described in Koshi are not intended as a transmission coding, but rather are associated with a method for statically compressing the image to a particular uniform size based on the quality of the image tone while the image is in page memory. Thus, since Koshi has no bearing on speech coding and transmission as described in Arnold, one of ordinary skill in the art would have no motivation to combine Koshi with Arnold. The lack of motivation cannot simply be ignored by the Examiner.

Secondly, the Examiner has clearly used impermissible hindsight to assemble the prior art in a piecemeal fashion. The impermissible hindsight is most likely the result of a computer search conducted by the Examiner based on the use of overly narrow search terms in an attempt to exactly match the language of the claims. Such an approach, in and of itself, is a classic example of using the specification and claims as a roadmap to piece together the teachings of the prior art which is improper. “[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teaching of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992). A

computer search of the art conducted by simply entering claim terms, while likely to produce results which, at first glance, may appear highly relevant, cannot be relied upon without careful review of the individual results and the applicable legal standards. Applicant is not suggesting that the use of computerized searching is improper, but rather that without careful consideration of the search terms used, and analysis of the resulting references with regard to the applicable legal standards, a computer search can produce references that, but for coincidentally containing the searched terms, would otherwise be irrelevant. Such is the case here.

Lastly, for at least the reasons set forth hereinabove, even if the combination is properly supported and no improper hindsight was used, the combination of Arnold and Koshi still fails to teach or suggest all the claimed features as required. For example, Arnold, and thus the combination fails to teach or suggest the first and second encoders producing first and second transmission data and the claimed multiplexer selecting between the first and second encoders.

Accordingly, serious defects are present in establishing the *prima facie* case of obviousness which cannot simply be ignored and which would undoubtedly fail to survive the additional internal scrutiny of, for example, a pre-appeal review. It is respectfully requested that the Examiner meet the burden of establishing a *prima facie* case of obviousness by providing the evidence of proper support for the combination of Arnold and Koshi, and by showing exactly where the elements of the claimed invention are taught or suggested in the combination, or by withdrawing the rejection. Since, for at least the reasons set forth above, applicants believe that no evidence can be provided and that the art combination fails to teach or suggest all the claimed features, it is respectfully requested that the rejection of independent claims 2, 11 and 20 be reconsidered and withdrawn.

Claims 6-7, 17 and 21, by virtue of depending from independent claims 2, 11 and 20, are allowable for at least the reasons set forth hereinabove. It is respectfully requested therefore that the rejection of claims 6-7, 17 and 21 be reconsidered and withdrawn.

Claims 3, 4 and 12-14 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Arnold in view of Koshi as applied above and further in view of Judd et al., U.S. Patent No. 6,701,137 (hereinafter "Judd"). The rejection is respectfully traversed.

Claims 3, 4 and 12-14, by virtue of depending from claims 1 and 11, are allowable for at least the reasons set forth hereinabove with regard to claims 1 and 11. In addition claims 3, 4 and 12-14 are independently allowable in that, for the reasons noted above, evidence is lacking to support the combination of Arnold and Koshi and the combination does not teach or suggest the features of the base claims. Further, the Examiner has not provided additional evidence showing a suggestion or motivation in the references that would drive one of ordinary skill in the art to add Judd to the already improper combination of Arnold and Koshi.

Accordingly, a *prima facie* case of obviousness has not properly been established in that the Examiner has provided no evidence to support the applied art combination. Further claims 3, 4 and 12-14 depend from allowable claims 1 and 11. It is respectfully requested that the rejection of claims 3, 4 and 12-14 be reconsidered and withdrawn.

Claims 5, 15 and 16 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Arnold in view of Koshi as applied above and further in view of Martone et al., U.S. Patent No. 6,603,806 (hereinafter "Martone"). The rejection is respectfully traversed.

Claims 5, 15 and 16 by virtue of depending from claims 1 and 11 are allowable for at least the reasons set forth hereinabove with regard to claims 1 and 11. In addition claims 5, 15 and 16 are independently allowable in that, for the reasons noted above, evidence is lacking to

support the combination of Arnold and Koshi and the combination does not teach or suggest the claimed features.

Further, the Examiner has not provided additional evidence showing a suggestion or motivation in the references that would guide one of ordinary skill in the art to add Martone to the already improper combination of Arnold and Koshi.

Accordingly, a *prima facie* case of obviousness has not properly been established in that the Examiner has provided no evidence to support the applied art combination. Further claims 5, 15 and 16 depend from allowable claims 1 and 11. It is respectfully requested that the rejection of claims 5, 15 and 16 be reconsidered and withdrawn.

Claims 22-23 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Arnold in view of Koshi as applied above and further in view of Fujiki et al., U.S. Patent No. 6,847,807 (hereinafter "Fujiki"). The rejection is respectfully traversed.

As noted at the outset, the Fujiki reference does not appear in either of the forms PTO-892 that accompanied the Office Actions of May 12, 2005 and August 24, 2004 issued to date in connection with the present application, and were not cited in an Information Disclosure Statement. Applicants respectfully request that the Examiner list Fujiki on a Supplemental Form PTO-892 in the next communication from the PTO regarding the present application.

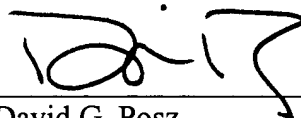
Claims 22-23, by virtue of depending from claim 20 is allowable for at least the reasons set forth hereinabove with regard to claim 20. In addition claims 22-23 are independently allowable in that, for the reasons noted above, evidence is lacking to support the combination of Arnold and Koshi and the combination does not teach or suggest the claimed features. Further, the Examiner has not provided additional evidence showing a suggestion or motivation in the references that would drive one of ordinary skill in the art to add Fujiki to the already improper combination of Arnold and Koshi.

Accordingly, a *prima facie* case of obviousness has not properly been established in that the Examiner has provided no evidence to support the applied art combination. Further claims 22-23 depend from allowable claim 20. It is respectfully requested that the rejection of claims 22-23 be reconsidered and withdrawn.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. G. Posz', written over a horizontal line.

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